

**IN THE DRAWINGS**

Replacement figures are presented in Appendix A. The replacement figures are provided on seven (7) sheets of drawings and contain Figs. 1-7. The replacement figures include proposed changes to Figs. 3, 4, 5, and 7. The proposed changes to the figures and the basis for those changes as described in the remarks section of this paper.

The replacement figures are believed free from new matter, because the proposed changes are believed to be fully supported by the specification, claims and drawings as originally filed. Thus Applicants submit that the replacement drawings contain no new matter.

In view of the foregoing, Applicants respectfully request that the Examiner enter the replacement figures into the application and acknowledge acceptance of the replacement sheets in the next Office Action.

**REMARKS**

**Summary of the Response to Office Action**

This Amendment responds to the Office Action mailed on October 5, 2006. Claims 1-4 and new claims 5-16 are pending in this application. Accordingly, claims 1-4 are respectfully submitted for reconsideration by the Examiner, and new claims 5-16 are presented for the Examiner's review and consideration. In addition, revised drawing sheets (Appendix A) are presented for the Examiner's review and consideration in response to objections and informalities raised in the Office Action. No new matter has been added as the amendments and new claims are believed to be fully supported by the specification, claims and drawings as originally filed.

**Objection to the Drawings**

Proposed changes to drawing figures 3, 4, 5, and 7 are presented in Appendix A.

In the Office Action, the drawings were objected to for not including reference sign W, which is mentioned in the specification. As described in the specification, FIGS. 3-5 show a driving guide mechanism in various states of driving a nail in to a work. (e.g., Specification, 6:23-26 to 7:3, 11:3-6, 11:16-17 and 12:1-7). Reference element W has been added to FIGS. 3-5 to clarify this point. Because the proposed changes to FIGS. 3-5 are fully supported by the specification as originally filed, there is no issue of new matter.

Drawing figure 7 was objected to under MPEP § 608.02(g) as illustrating prior art without an appropriate legend. FIG. 7 has been amended to include such a legend.

Applicants respectfully request that Examiner approve the proposed changes to the drawings and withdraw the objections to thereto.

**Objections to the Specification Under MPEP 608.01(a)**

In the Office Action, the specification was objected to because of informalities. In particular, the specification was objected to on page 7 because reference element "19" should be

“18” to be consistent with the drawings. Applicants have amended the specification accordingly. Because this change is supported by the specification, claims and drawings as originally filed, Applicants respectfully submit that there is no issue of new matter.

The title of the invention was objected to as not descriptive. Applicants respectfully disagree. As required by 37 C.F.R. 1.72 and MPEP § 606.01 the application title “POWER-DRIVEN NAILING MACHINE” is clearly indicative of the claimed invention, because the claims recite features of a power-driven nailing machine. Thus, no further description is believed necessary. In view of the above, Applicants respectfully request that the objections to the title be withdrawn, at least until time of allowance.

#### **Rejections to the Claims Under 35 U.S.C. § 112**

Claims 1-4 were rejected under 35 U.S.C. §112, second paragraph for failing to point out and distinctly claim subject matter Applicants regard as the invention. The Examiner stated in connection with claim 1, “it is not clear what ‘maximum sized nail’ encompass.” Applicants respectfully traverse.

Claim 1 recites a power-driven nailing machine comprising, in part, a contact nose that “includes a leading end discharge port for guiding a nail driven from the discharge port toward a work.” Claim 1 also recites that “the leading end discharge port includes a guide portion longer than a maximum sized nail.” In the context of claim 1, the term “maximum sized nail” is defined relative to the length of the claimed guide portion. Accordingly, claim 1 when considered as a whole is clear, and thus serves the notice function required by 35 U.S.C. §112, second paragraph. *See* MPEP § 2173.02. Moreover, the term “maximum sized nail” is consistently described in the specification with the same general meaning. *See e.g.*, Specification; page 5, line 20 to page 6 line 16 and page 12, lines 8-11. Thus, claim 1 also satisfies the notice function required by 35 U.S.C. §112, second paragraph because one of ordinary skill in the art would understand what is claimed by the term “maximum sized nail” when read in light of the specification. *Id.*

Claims 2-4 which depend from claim 1 are believed to be in compliance with the requirements of 35 U.S.C. §112, second paragraph for the same reasons as independent claim 1.

**Rejections to the Claims Under 35 U.S.C. § 102(b)/103(a)**

Claims 1-4 were rejected as anticipated by “applicant’s admitted prior art (hereinafter “AAPA”) as shown in figure 7 and described in pages 1-5 of the specification.” Applicants respectfully traverse.

Claim 1 recites, in part, a power-driven nailing machine comprising “a contact nose arranged to be protrusively urged toward a leading end of the nose body, wherein the contact nose includes a leading end discharge port for guiding a nail driven from the discharge port toward a work, the leading end discharge port includes a guide portion longer than a maximum sized nail.” Drawing figure 7 and the relevant pages 1-5 of the specification cited by the examiner fail to disclose a contact nose with “a guide portion longer than a maximum sized nail,” as required by claim 1. Instead, they disclose a nailing machine with a contact nose (31) having a length less than the nail driven from the discharge port (32). (Specification, page 3 lines 1-4). Thus, the cited disclosure does not disclose a “contact nose” as recited by claim 1. Moreover, deeming a claim limitation anticipated without express or inherent disclosure is improper, and thus cannot remedy the deficiency of the AAPA. Accordingly, claim 1 is not anticipated.

Claims 2-4, which depend from claim 1, are believed patentable over the cited AAPA for the same reasons as claim 1, as well as for the particular features they recite. For example, the cited AAPA also fails to anticipate a contact nose having:

- a “cylindrical portion,” as recited in claim 2; or
- a “second tapered guide portion” as recited in claim 4.

**Claims 1-4 are not obvious over the cited AAPA in view of Kristiansen**

Claims 1-4 were rejected as being obvious over the cited AAPA in view of U.S. Patent No. 1,241,996 to Kristiansen (“Kristiansen”). Applicants respectfully traverse.

Kristiansen is directed to a tool for nailing parquet floors. (Kristiansen, 1:9-12). Kristiansen discloses a hammer operated with a hammer guide and support 9 provided with an upper stop 10 and a foot 11 having a mouth or outlet 12 through which nails 13 are forced from the tool. (Id., 1:41-46). The foot is further provided with a flared portion 16 having a groove 26

for guiding nails to the outlet 12. (Id., 1: 51-54). Thus, the foot disclosed by Kristiansen is fixed with respect to the hammer guide. By contrast, the contact nose and nose body disclosed in the cited AAPA move with respect to each other. Accordingly, one of ordinary skill would not be motivated to combine these references.

Moreover, even if one were to combine Kristiansen with the cited AAPA, Kristiansen fails to remedy the deficiencies of the cited AAPA. As stated above the cited AAPA fails to disclose a contact nose with “a guide portion longer than a maximum sized nail,” as recited in claim 1. Combining the cited AAPA with Kristiansen does not remedy this deficiency because Kristiansen is silent concerning the length of the outlet relative to a maximum sized nail that can be used with the tool. Thus, claim 1 is not obvious over the AAPA in view of Kristiansen.

Claims 2-4, which depend from claim 1, and are believed patentable over the cited references for the same reasons as claim 1, as well as for the particular features they recite. For example, both the cited AAPA and Kristiansen neither disclose nor suggest:

- a contact nose with “a cylindrical portion...held slidably along the discharge port of the nose body,” as recited by claim 2; or
- a contact nose with a “second tapered guide portion” as recited by claim 4.

### New Claims 5-7

New claims 5-7 depend from original claim 1 and recite additional features of the claimed power-driven nailing machine. Accordingly, claims 5-7 are believed patentable over the cited reference and AAPA for the same reasons as claim 1, as well as for the respective features they recite. New claims 5-7 are believed supported by the specification and drawings as originally filed. Thus, Applicants submit that there is no issue of new matter.

### New Claims 8-16

New independent claim 8 is directed to a power-driven nailing machine adapted to drive at least one sized nail into a work piece. The at least one sized nail includes a maximum sized nail. Claim 8 is believed to be patentable over the cited reference and the AAPA because they do

not disclose or suggest at least the combination of a “nose body,” “hollow member,” and “guide portion,” recited by claim 8. Claims 9-16, which depend or ultimately depend from claim 8, are believed patentable over the cited reference and AAPA for the same reasons as claim 8, as well as for the respective features they recite. New claims 8-16 are believed supported by the specification and drawings as originally filed. Thus, Applicants submit that there is no issue of new matter.

**CONCLUSION**

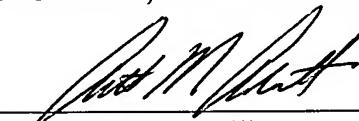
In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance, and thus request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By:

  
\_\_\_\_\_  
Arthur M. Antonelli  
Reg. No. 51,410

Dated: December 26, 2006

**Customer No.: 009629**

**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Telephone: 202-739-3000  
Facsimile: 202-739-3001